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cont.

19. The method according to claim 17,
wherein said edited video data is generated such that said
edited video data is reproduced from said disc medium with said
second data rate, and said edited video data is recorded on said tape
medium with said second data rate.

20. The method according to claim 17,
wherein said edited video data is generated such that said
edited video data is reproduced from said disc medium with said first
data rate, and said edited video data is recorded on said tape
medium with said first data rate.--

REMARKS

Claims 1 and 8-15 were pending in this application. Claim 1 has been canceled. Claims 8, 10-11, and 14-15 have been amended. New claims 16-20 have been added to further claim applicants' invention. The specification has been amended to correct typographical and grammatical errors and to conform to the drawings. It is respectfully submitted that such amendments are supported by the specification, claims, abstract of the disclosure and the drawings as originally filed, and that no new matter has been added.

Double Patenting

The Examiner provisionally rejects claim 1 under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 08/563,188.

In response, claim 1 has been canceled.

Claim Rejections under 35 U.S.C. § 103

The Examiner rejects claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Schnorf, U.S. Patent No. 5,367,341, in view of Lang, U.S. Patent No. 5,164,839.

In response, applicants have canceled claim 1.

The Examiner rejects claims 8-9 and 13-15 under 35 U.S.C. § 103(a) as being unpatentable over Sasho et al., U.S. Patent No. 5,103,348 (hereinafter Sasho) in view of Koishi, U.S. Patent No. 5,420,690.

Regarding claims 8 and 13-15, the Examiner states that Sasho in Fig. 2 discloses a video data recording and reproducing system for editing source video data having a VTR for recording a source video data onto a tape medium with a first data rate during a recording period and for reproducing recorded source video data from said tape medium with a second data rate which is higher than said first transfer rate to generate video data (see col. 2, lines 30-35, and col. 4, lines 8-30); a recording means (9) for recording said reproduced video data onto a medium with said data rate so that said source video data is copied from said tape medium to said disc medium during a transfer period which is shorter than said recording period of said source video data (since the source tape players [10 A, B] can reproduce recorded information at a tape speed higher than normal [col. 4, lines 25-30] to be recorded by the recording unit (9), Sasho meets the limitation of recording the video information at a second rate higher than the first rate or real time rate).

The Examiner further states that Sasho discloses an editing means for controlling a reproduction operation of a recording means to generate an edited video data comprising a plurality of edit portions which are designated by the operation from source video

data recorded on the recording means (see col. 3, line 44 to col. 4, line 7 and Fig. 4).

In response, applicants note that Sasho's tape recording means (9) is not a **disc** recording means as recited in claim 8, and that Sasho fails to teach the recited disc recording means. (The vague suggestion at Sasho's col. 10, lines 12-16 does not amount to such teaching.)

Even assuming for the sake of argument that Sasho's **tape** recording means (9) corresponds to the claimed **disc** recording means, applicants respectfully submit that Sasho fails to disclose the claimed editing means. Sasho discloses that the editing apparatus (1) causes the tape players (10A and/or 10B) to reproduce output at a first (low) or second (high) rate. See col. 4, lines 2-6. On the contrary, the claimed editing means controls a **reproducing** operation of a the disc recording means (on which reproduced video data has been recorded at a high rate) to generate edited video data. To the extent that Sasho's tape recording unit (9) corresponds to the claimed disc recording means, applicants contend that the control of a reproducing operation of Sasho's tape players 10A and/or 10B does not correspond to control of a reproducing operation of the claimed disc recording means. Sasho fails to teach that a reproducing operation of **recording unit 9** (or any element even arguably corresponding to the claimed disc recording means) should be controlled to generate edited video data. Thus, applicants respectfully submit that the Examiner's rejection is erroneous.

The Examiner concedes that Sasho fails to disclose the recording medium being a disc and wherein the information recorded can be recorded at a higher rate and reproduced at a lower/same rate and wherein the video information can be recorded at a normal rate and reproduced at the same or higher rate.

The Examiner states that Koishi teaches utilization of a disc recording medium having the advantage of random access of video information recorded on the disc recording medium. The Examiner further states that Koishi teaches recording source material at a normal/real time rate and reproducing information at a higher rate than normal/real time. The Examiner further states that Koishi teaches recording information at a higher rate than normal/real time and reproducing the information at the normal/real time rate (see Figs. 1-2) in order to reduce the time during which the transmission occupies the transmission line can be realized. The Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sasho by providing the disc apparatus and medium with associated functionality as taught by Koishi in order to reduce the time during which the transmission occupies the transmission line can be realized.

In response, applicants respectfully traverse the Examiner's rejection. To establish prima facie obviousness, the combination of references must teach or suggest all the claim limitations. See MPEP § 2142. Applicants respectfully submit that the Examiner has failed to show how Sasho in view of Koishi teaches or suggests all the claim limitations of claims 8 and 13-15.

Initially, applicants refer the Examiner back to the issues discussed above regarding the disc recording means, the tape recording means, and the editing means. These expressly cited claim features must be met by Sasho or by Sasho in view of Koishi (as set forth by the Examiner). Applicants respectfully submit that the Examiner has failed to show how these features are met by Sasho or by Sasho in view of Koishi.

Furthermore, applicants respectfully submit that the Examiner has failed to provide a motivation to combine Sasho and Koishi. The rule is that there must be some motivation or suggestion, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See MPEP § 2142. The Examiner states that the motivation is to reduce the time during which the transmission occupies the transmission line can be realized. However, Sasho itself already discloses that the tape speed may be increased by up to three times. See col. 4, lines 25-30. Thus, Sasho does not need Koishi to reduce the transmission time. Therefore, applicants respectfully submit that the Examiner has failed to provide a motivation to combine Sasho and Koishi.

On the other hand, applicants respectfully submit that applicants' invention is not suggested by the combined teachings of the cited references. The prior art is disadvantaged by the sequential access of the tape apparatus during generation of edited video data. See the specification at page 1, lines 16-20. Applicants' invention solves this problem by recording data at a high rate on a disc that enables random access of the data, and controlling **reproduction of the data recorded on the disc** to generate edited video data. See the specification at page 5, lines 10-14. In the context of claim 8, this enhances the function of the editing means because the editing means operates by reproducing the data recorded on the disc. Further, neither Sasho nor Koishi teaches recording data at a higher than normal rate on either a disc or tape unit, and controlling a reproducing operation of **such disc or tape unit** (i.e., the one on which data has been recorded at the higher than normal rate) to generate edited video data. Thus, applicants

respectfully submit that claim 8 is allowable over Sasho and over Sasho in view of Koishi.

Regarding claim 13, applicants respectfully submit that the Examiner has failed to show that Sasho in view of Koishi teaches or suggests all the claim features. Claim 13 recites that the tape means has first and second recording/reproducing operation modes, the disc means has first and second recording/reproducing operation modes, and the editing means controls the operation modes. On the other hand, Sasho discloses that the editing apparatus controls the recording operation modes of the tape device (9) and the reproducing operation modes of the tape devices (10). See the abstract and FIG. 2 of Sasho. Nothing in Sasho or Koishi, as understood, teaches or suggests that the editing apparatus controls **both** the recording and reproducing of a tape means, or of a disc means, as recited in claim 13.

Regarding claims 14-15, applicants respectfully submit that these claims are allowable as claims dependent from allowable amended claim 8, as argued above.

Regarding claim 9, the Examiner states that the combination of Koishi and Sasho meets the limitations of wherein the editing means controls the reproduction operation of the disc recording means so that the edited video data is reproduced from the disc medium with the first or second rate (see Koishi col. 6, lines 5-27 and Abstract).

In response, applicants respectfully traverse the rejection. Koishi, as understood, discloses that the transmitter side player reproduces at the high speed and the normal speed, and that the receiver side player records at the high speed and reproduces at the normal speed. See col. 6, lines 5-58. On the other hand, claim 9 recites that the disc reproducing means reproduces at the first or

second data rate. Because claim 8 recites that the disc means receives from the tape means, the appropriate analogue to Koishi is that Koishi's receiver side player corresponds to the claimed disc means. However, Koishi's receiver side player reproduces at the normal speed. Koishi fails to teach or suggest that the receiver side player reproduces at the high speed as well. Thus, applicants respectfully submit that claim 9 is allowable over Sasho in view of Koishi.

The Examiner rejects claims 10-12 under 35 U.S.C. § 103(a) as being unpatentable over Sasho and Koishi in view of Schnorf, U.S. Patent No. 5,367,341. The Examiner concedes that the combination of Sasho and Koishi fails to disclose the operation of transferring information between the disc and tape recording and reproducing means. The Examiner states that Schnorf teaches an editing configuration of having multiple record and reproduction units (DISC, TAPE, etc.) connected to a bi-directional bus to provide the ability to record and/or reproduce to or from any recording or reproducing unit connected to the bi-directional communication transfer means (see Fig. 3). The Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Sasho and Koishi by incorporating a bi-directional bus between recording and reproducing elements of the editing system as taught by Schnorf having the advantage of transferring data to or from any recording and reproducing unit connected to the bi-directional bus as taught by Schnorf.

In response, applicants respectfully traverse the rejection. Claim 10 recites (in combination with its parent claim 8) a tape means that can record at a first rate ("R1"), can record at a second rate ("R2"), and can reproduce at R2; and a disc means that can

record at R2 and can reproduce at R2. On the other hand, Sasho discloses that the recorder (9) records at R1 (see col. 4, lines 18-20) and the reproducer (10) reproduces at R1 or R2 (see col. 4, lines 25-30). Thus, Sasho fails to disclose that its devices both record and reproduce, and thereby fails to disclose the rates of the undisclosed recording and reproducing. Koishi fails to remedy this defect because Koishi discloses that one device reproduces at R2 (see FIGS. 1a-1c) and that the other device records at R2 and reproduces at R1 (see FIGS. 1d-1f). Thus, Koishi fails to disclose that the tape means can record at R1 and can reproduce at R2, and fails to disclose that the disc means can reproduce at R2 (using Koishi's device of FIGS. 1d-1f) or can record at R2 (using Koishi's device of FIGS. 1a-1c). Schnorf fails to remedy this defect because Schnorf only discloses one rate. See col. 6, line 1; and col. 8, lines 44-47. Because none of the references disclose applicants' invention as recited in claim 10, it is respectfully submitted that this defect cannot be remedied by merely stating that the references in combination teach the claim elements. For each claim element that is not disclosed by a reference, the Examiner must show how that claim element is disclosed by combination with another reference and why there is a motivation to combine the references. Because the Examiner has failed to do this for claim 10, applicants respectfully submit that claim 10 is allowable.

Claim 11 recites that the tape means records at R1 and reproduces at R2. As detailed above, neither Sasho, Koishi, nor Schnorf discloses this feature. Because the Examiner has failed to show how these claim elements are disclosed by a combination of references and how that combination is motivated, applicants respectfully submit that claim 11 is allowable.

Applicants respectfully submit that claim 12 is allowable as a claim dependent from allowable claim 11, as argued above.

New Claims

New claim 16 corresponds to amended claim 8. Applicants respectfully submit that claim 16 is allowable for the reasons given above regarding claim 8.

New claims 17-20 correspond to claims 8-11, respectively. Applicants respectfully submit that claims 17-20 are allowable for the reasons given above regarding claims 8-11, respectively.

Conclusion

In view of the above, it is respectfully submitted that the application is now in condition for allowance. The Examiner's reconsideration and further examination are respectfully requested.

Respectfully submitted,
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